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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,660	07/20/2000	Marcel Linschoten	1103326 0630	9005

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White & Case
1155 Avenue of the Americas
New York, NY 10036-2787

EXAMINER

COVINGTON, RAYMOND K

ART UNIT PAPER NUMBER

1625

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,660

Applicant(s)

Linschoten et al

Examiner

Raymond Covington

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/7/02
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-9 and 12-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Election/Restriction

1. Restriction to one of the following invention is required under 35 U.S.C. 121:
 - I. Claims 1-9, 18-23, drawn to products.
 - II. Claims 12, 13, 16, 17 and 26, drawn to method of use.
 - III. Claims 14 and 24, drawn to processes.
 - IV. Claims 15 and 25 drawn to kits.
2. The above groups are identified as general areas. Accordingly, as groups, they are independent or distinct as the compounds of group I would be capable of preparation by more than one process, as seen in claim 36 or claim 37. The compounds would be capable of more than one use, e.g. treating arthritis, bone resorption, Alzheimer's disease, Parkinson's disease, etc., and separate search considerations are involved, which would impose a burden if unrestricted.
3. The above groups themselves are inclusive of patentably distinct subject matter. Accordingly, along with the election of one of the above groups, the following action is also taken.
4. Claim 1 is generic to plurality of disclosed patentably distinct species comprising, for example, the compounds of (1) Example 1, page 37, etc., (2) a method of treating a disease using the compounds as in Example 1, etc. and (3) a method of preparing the compounds as in Example 1, etc. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

5. Upon the election of a single disclosed species (e.g. Example, page number, structural depiction), a generic concept, inclusive of the elected species, will be identified by the Examiner for examination. Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon.

1. Claims 1-9, 18-26 are drawn to more than one patentably distinct area of invention (under 35 USC 121), joined together via means of "Markush" type claims, and accordingly, election of a single species is required as per the provisions of MPEP 803.02.

The claims as presented contain such a vast multitude of possible compounds due to the "possibilities and permutations" that are present that it is not possible to identify each and every species encompassed in the claims. Accordingly, to facilitate election, Applicants are required to elect a single specific compound and upon each election, the Examiner will review the claims and indicate (a) a generic concept inclusive of the elected species (compounds which are so similar thereto as to be part of the elected matter) and (b) by such indication (i.e. by exclusion) which compounds are drawn to non-elected subject matter. Further, whatever compounds are ultimately treated together, so too will any compositions containing such active compounds.

It is considered that the "Markush" type claims encompassing such species are directed to multiple "independent and distinct inventions" since the species encompass compounds that are so unrelated and diverse that a prior art reference anticipating the claims with respect to one of the species will not render the claims obvious under 35 USC 103 with respect to any of the other species. Further, these claims encompass species that are considered to be independent since they are unconnected in operation, one does not require the other for ultimate use, and the specification does not disclose a dependent relationship between them. Moreover, there are encompassed species that are considered to be distinct from others on the basis of their properties. Also, it is an undue burden on the PTO to act on more than one invention in one case. Thus, this application contains species that are capable of supporting separate patents under 35 USC 121.

Accordingly, Applicants are required to make a provisional election of a single independent and distinct species of compounds as noted above prior to the examination of said claim on the merits. This election will be given effect in the event that the "Markush" type claims are not found allowable, at which time the examination of the claims presented will be limited to the "Markush" type claims directed solely to the elected species, with claims directed solely to the non-elected species being held withdrawn from further consideration. It should be noted that an election of species had been held to be a tantamount to a requirement for restriction (*In re Herrick*, 1958 C.D. 1 and *In re Joyce*, 1958 C.D. 2) and enjoys the benefit of 35 USC 121.

Applicant's response must include a provisional election as noted above, even though this requirement is traversed (37 CFR 1.142 and 1.143). Applicants are also advised that any traversal must be supported by specific arguments in order to perfect the right to petition.

Any inquiry concerning this communication should be directed to Raymond Covington at telephone number (703) 308-4704.

R
Covington/LR

March 12, 2002

Alan L. Rotman

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